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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,556	06/13/2001	Harold Brodie	S1011	9517

3000 7590 09/20/2002

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/20/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,556

me 9
Applicant(s)

BRODIE ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Reissue Applications

Oath/Declaration

1. The reissue oath/declaration filed with this application is defective because
 - (a) it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.
2. Claims 1-32 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action. Also the declaration is confusing as it states that some of the claims are not amended “except to be dependent from claim 1 or 2”. This is confusing because if a change was made to a claim it is considered to be “amended”. Correction is requested.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12-13 and 17-32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

No literal support can be found in the specification for the claimed subject matter.

5. Claims 12-13 and 17-32 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claims 12 and 17 applicant recites “resin based powder” which is broader than that of the disclosure as the disclosure requires that the powder be a polymer powder. Applicant argues that the phrase is taught by the disclosure as the disclosure discloses resin based powders. It is the position of the examiner that support lacks for the broad term “resin based” as this encompasses both natural and synthetic resins and natural resins do not appear to be contemplated by the reference based on the types of polymers taught by the disclosure.

In claim 18 applicant recites “a powder coating pre-mix” which is broader than that of the disclosure as the disclosure requires that the powder be a polymer powder. Applicant points to page 4, lines 9-11 of the disclosure for support however it is not seen as to where this part of the disclosure makes any mention as to a “pre-mix”. Clarification is requested.

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In claims 19-20 and 30 applicant recites that the biocide is a liquid which is not taught by the specification. Applicant argues that this is supported by the fact that the disclosure recites “The criteria for a suitable biocide is that the biocide can be provided in suitable powder form and that it can survive the coating process” and that “A skilled person in this field would be aware that liquid biocides can be mixed with a suitable support matrix to form a powdered biocide suitable for this application”. It is the position of the examiner that one would not find it obvious to use liquid biocides as the disclosure recites “suitable powder form”. It is not seen as to how one can conclude that liquid biocides would be a “suitable powder form”. Applicant appears to be using “hind-sight” which is improper.

In claims 21-27 the types and amounts of biocides are not taught by the reference. Applicant argues that since the reference teaches that “Many biocides may be suitably employed in the invention and the average skilled man of the art would readily be able to determine by routine experimentation whether the biocidal activity of any particular biocide will be sufficiently retained from his particular needs in the coating”. It is the position of the examiner that the types found in the claims are not obvious from the disclosure as the particularly claimed types and amounts cannot be readily implied from the disclosure. That is, the particular types and amounts would require undue experimentation. Applicant appears to be using “hind-sight” which is improper.

In claim 28 applicant recites a temperature for baking the thermoplastic polymer however this is not supported by the specification. Applicant argues that “it is obvious to the skilled worker in this field that the baking temperature should be adjusted accordingly when using

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thermoplastic polymer powders in place of thermosetting polymers, therefore this feature is implicit supported by the disclosure. It is the position of the examiner that this is not implicitly supported by the reference as the reference provides no guidance as to baking thermoplastic polymer powders. Applicant appears to be using "hind-sight" which is improper.

In claim 29 applicant recites the use of a pre-mixer, and that the mixtures is melted and cooled which is not taught by the original disclosure. With respect to the pre-mixer, applicant argues that it would be obvious to a skilled worker in this field that a pre-mixer could be used to carry out this step". It is the position of the examiner that it cannot be readily implied from the disclosure to use a pre-mixer. Also the step of melting and cooling cannot be readily implied by one of ordinary skill in the art by the teachings of the disclosure. Again applicant appears to be using "hind-sight" which is improper.

In claims 31 and 32 applicant recites various process steps that are not found in the process recited in the original disclosure. No arguments are provided which show wherein the support lies in the disclosure.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-10, 12-17, 19-27 and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is confusing as written as it is unclear as to whether the particles each comprise a thermosetting polymer powder and an organic biocide or if the composition contains both polymer powders and an organic biocide (i.e. separate from each other). Clarification is requested.

In claim 9 the phrase “the polymer particles” lacks proper antecedent basis.

In claim 10 the phrase “the granules” lacks proper antecedent basis.

In claim 12 the phrase “the particles” lacks proper antecedent basis. It is unclear as to the types of resin based powders encompassed by the claim.

Claim 13 is confusing as it is unclear as to whether or not the “thermosetting and/or thermoplastic compositions” are used as the resin based powder or if they are in addition to the powder. The claim is inconsistent with claim 12 as claim 12 recites “an anti-microbial agent” whereas claim 13 recites “one or more”.

Claim 14 is confusing as it recites that “an anti-microbial agent further comprises solid anti-microbial agents”. That is, the phrase “an anti-microbial agent” seems to suggest “1” agent not multiple agents.

Claim 15 is confusing as written as it is unclear as to whether the particles each comprise a thermosetting polymer powder and an organic biocide or if the composition contains both

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polymer powders and an organic biocide (i.e. separate from each other). Clarification is requested.

Claim 16 is confusing as written as it is unclear as to whether the particles each comprise a thermoplastic polymer powder and an organic biocide or if the composition contains both polymer powders and an organic biocide (i.e. separate from each other). Clarification is requested.

In claim 17 it is unclear as to the types of resin based powders encompassed by the claim.

In claim 18 it is unclear as to the types of powder coating pre-mix encompassed by the claim. It is unclear as to the amount of anti-microbial agent encompassed by the claim.

In claim 29 the phrases “the components”, “the mixture” and “the solid extrudate” lacks proper antecedent basis.

In claim 31 the phrases “the powder coating particles” and “the coating powder particles” lacks proper antecedent basis. The step of “impacting them with particles” is not understood.

In claim 32 the phrases “the other components” and “the powder coating formulation” lack proper antecedent basis. The phrase “which can be processed” is not a positive claim recitation.

8. Claims 1-9 and 12-32 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball*

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Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the parent application applicant amended the claims to recite (1) that the polymer powder is a thermosetting polymer, (2) that the biocide is organic in nature and (3) that the composition is in the form of particulates each comprising the polymer powder containing the biocide in order to overcome the art rejections and accordingly since all these limitations are not present in independent claims 1, 12, and 15-18 it appears that applicant is attempting to recapture subject matter surrendered in the parent application. Applicant's attention is drawn to the pages 4-5 of the response filed on 21 May 1999 in the parent application wherein applicant argues that the insertion of these limitations overcomes the art rejections.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 12, 14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cueman et al (US Patent No. 5,238,749).

The reference teaches an antimicrobial composition comprising a thermoplastic or thermosetting powder and an antimicrobial agent (see col. 4, lines 45-55, col. 6, lines 34- 45 and col. 8, lines 1-19).

No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 12 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference. Applicant argues that the composition of the reference is not homogeneous and that they have reproduced the compositions and when compared to the claimed invention the compositions do not achieve applicants benefits and the applicant's would be willing to submit this information in declaration form at the Examiner's request. It is the position of the examiner that applicant's need to provide evidence in declaration form showing that the invention of the reference differs from that which is claimed.

11. Claims 12, 14, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 06-025561.

The reference teaches, according to the abstract (WPIDS 94-072114), an antibacterial paint composition comprising a nylon powder and a powdery biocidal agent.

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No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 12 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference.

Applicant argues that the instant claims are not met by the reference however no evidence is provided showing this.

12. Claims 12-14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 08-060036.

The reference teaches, according to the abstract (JP408060036A), an antibacterial, antifungal polyester resin composition comprising a polyester powder and zeolite carrying an antibacterial, antifungal metal in powder form.

No significant differences can be seen between the instant claims and the reference. It is the position of the examiner, that the terminology used in claim 12 reads on a mixture of a powdered resin and an antimicrobial agent and this is taught by the reference.

Applicant argues that the instant claims are not met by the reference however no evidence is provided showing this.

Double Patenting

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13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 15 and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11 and 13 of prior U.S. Patent No. 6,129,782. This is a double patenting rejection.

Applicant's have not provided any arguments concerning this rejection and accordingly it is repeated.

Request To Provoke Interference

15. Applicant's request to provoke an interference is acknowledged however it should be noted that no interference can be declared until there is at least one allowable claim which corresponds to a proposed count of the interference.

Surrender Of Original Patent

16. Applicant is reminded that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

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Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

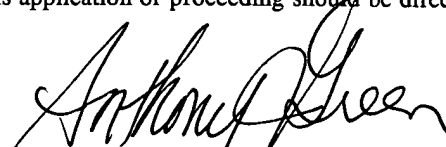
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Green whose telephone number is (703) 308-3819. The examiner can normally be reached on Monday - Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone numbers for the Group are as follows:

- (i) (703) 872-9310 for any non-final amendment or communication, and
- (ii) (703) 872-9311 for any after-final amendment or communication.

It is suggested that the examiner be notified that a fax has been sent to ensure prompt handling of the amendment or communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


ANTHONY GREEN
PRIMARY EXAMINER
ART UNIT 1755

ajg
August 1, 2002